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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/589,656	08/16/2006	Jan D. Boness	N89296	9985
1333 7590 06/22/2010 EASTMAN KODAK COMPANY PATENT LEGAL STAFF 343 STATE STREET ROCHESTER, NY 14650-2201			EXAMINER TZENG, MICHAEL Y	
			ART UNIT	PAPER NUMBER
			2625	
			MAIL DATE	DELIVERY MODE
			06/22/2010 PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/589,656

**Applicant(s)**

BONESS, JAN D.

**Examiner**

Michael Tzeng

**Art Unit**

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 March 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

#### ***Response to Amendment***

1. Applicant's amendment filed on 3/22/2010 has been entered. Claims 1-4 have been amended. No claims have been canceled. No claims have been added. Claims 1-4 are still pending in this application, with claims 1 and 4 being independent.

#### ***Response to Arguments***

2. Applicant's arguments filed with regards to claim 1 have been fully considered but they are not persuasive.

3. Applicant argues that "a single sensor for detecting marks on both sides of a sheet is not shown or, in any way taught, by the prior art" (See Remarks, page 4). However, as was disclosed previously, this would have been an obvious matter of design choice. Using a single sensor was well-known in the art to scan both sides of a document, as taught by Shogren (US Patent No. 4,673,285). Shogren teaches in the background that it was well-known to use a single scanner for a double-sided document, and in order to scan both sides, a document would have to be turned over.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benedict et al. (US Patent No. 5,488,458, hereinafter "Benedict").

In regards to **claim 1**, Benedict discloses method for the detection of marks (1, 1', 1'') by a sensor array (10) for a printing machine, wherein the marks (1) on a first printing side (5) of a sheet (3) are detected (Col. 2/line 36 discloses the printing of the marks on each side; col. 2 line 40 discloses the sensor of the mark on the first side), that the sheet (3) is turned over and shifted in a direction transverse to the transport direction, and that the marks (1') on a second printing side (6) of the sheet (3) are detected (Col. 2/line 36 discloses the printing of the marks on each side; col. 2 line 44 discloses the sensor of the mark on the second side). However, Benedict does not disclose where the sheet is flipped over and the same sensor is used to scan the second side.

It would have been obvious matter of design choice to combine the sensors into one to scan both sides, since applicant has not disclosed that this difference solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with two sensors.

**Claim 4** is rejected under the same grounds as claim 1.

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Benedict et al. (US Patent No. 5,488,458, hereinafter "Benedict") in view of Hubble, III et al. (US Patent No. 5,339,150, hereinafter "Hubble").

In regards to **claim 2**, which depends on claim 1, Benedict discloses the marks (1) on the first printing side (5) of the sheet (3) (Col. 2/line 36 discloses the printing of the marks on each side). However, Benedict does not disclose the marks in relation to the marks on the transport belt.

Hubble discloses a mark-detecting system. Col. 2 lines 48-50 discloses the detection of line marks on the transport belt.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the invention of Benedict to include the teaching of Hubble. The motivation for this is for better print quality that has been calibrated.

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Benedict et al. (US Patent No. 5,488,458, hereinafter "Benedict") and Hubble, III et al. (US Patent No. 5,339,150, hereinafter "Hubble") in view of Metzler (US Patent Application Publication No. US 2003/0029341 A1).

In regards to **claim 3**, which depends on claim 2, Benedict and Hubble disclose the marks and the transport belt, but do not disclose aligning the sheet with the transport belt.

Metzler teaches a method of printing calibration that aligns marks and are set in relation to a drum (abstract).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the invention of Benedict and Hubble to include the

teachings of Metzler. The motivation for this is for better printing alignment and better printing quality.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. DesForges et al. (US Patent No. 5,085,587) discloses the method of detecting marks on a scannable form.
9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Tzeng whose telephone number is (571) 270-7173. The examiner can normally be reached on Monday-Friday 7:30am-5pm EST with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Benny Q. Tieu can be reached on (571) 272-7490. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Benny Q Tieu/  
Supervisory Patent Examiner, Art Unit 2625

/Michael Tzeng/  
Examiner, Art Unit 2625